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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/613,341

07/03/2003

Neil Andrew Abercrombie Simpson

MRKS/0093

5149

7590

08/04/2005

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EXAMINER

PATEL, VISHAL A

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 08/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/613,341

Applicant(s)

SIMPSON ET AL.

Examiner

Vishal Patel

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,4-12,15-29,32,33,37,38 and 47-64 is/are pending in the application.
- 4a) Of the above claim(s) 33 and 49-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-12,15-29,32,37,38,47 and 48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1/27/05</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Newly submitted claims 49-64 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: As stated in the final Office action claims are directed to an invention that is nonelected (This application contains claims 30, 33-36 and 40-46 are drawn to an invention nonelected with traverse in applicant's response to the restriction requirement. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP j 821.01. As per applicant's remarks in the amendment claim 33 has also been withdrawn).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 49-64 withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

In conclusion claims 33 and 49-64 are withdrawn.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 4-12, 15-29, 32-33, 37-38, 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (US. 6,409,175) in view of Blose (US. 4,822,081).

Evans illustrates a diametrically expandable coupling arrangement for coupling diametrically expandable first and second tubulars (first and second tubulars as seen in figure 7-

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10). The coupling arrangement having a male thread portion on an end portion of a first member, a nose (nose 34a) along the end portion of the first tubular (26 or 34), a female thread portion on an end portion of a second tubular (27 or 33), the female thread and male thread portions are configured to threadably mate, an undercut groove (groove having wall 39a) along the end portion of the second tubular adapted to receive the nose (nose 34a received in the groove), the thread portions define a thread cut in an opposite direction (this is the case since the expansion tool can be inserted in both direction, see column 10, lines 15-19) to an intended direction of rotation of a rotary expansion tool (method limitation given non patentable weight in an apparatus claim) and include material properties that facilitate engagement of the threads (the threads have material properties to facilitate engagement of the female thread portion to the male thread portion) due to rotary expansion thereof (method limitation given non patentable weight in an apparatus claim). The coupling arrangement is dimensioned to accommodate relative axial extension between the first tubular and second tubular (this is the case due to expansion). A deformable seal within a groove of the coupling arrangement (seals 29 and 36). The deformable seal is made of elastomeric material (elastomeric material are known to swell when contacted with fluid) and is energized by relative axial extension of the first tubular (figures 7-10). The groove features a rounded recess angle (angle on wall 39a). The first and second tubulars comprise a seal member (29 and 36). The tubulars are metallic and so are the thread portions. As seen in figures 7-7B the nose is retained by the undercut groove.

Evans discloses the invention substantially as claimed above but fails to disclose that the threads are dovetail with flank angles greater than 10 degrees. Blose teaches a coupling includes male threaded portion (12) and a female threaded portion (13) wherein the threaded

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portion are dovetail threads having flanks inclined at an angle of greater than 10 degrees (see figures 1-4 and 6-8 for the dovetail threads and column 7, lines 14-57 disclosing flanks greater than 10 degrees and also the angles claimed in claims 4-9, as to claim 10 see figure 6, as to claim 11 see figure 11 and column 4, lines 50-55 and as to claims 12-18 see figure 6).

4. Claims 1, 16, 18, 20, 25, 27-29, 37 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans and Blose as applied to claim 1 above, and further in view of Kramer (US. 3,915,460).

Evans and Blose disclose the invention substantially as claimed above but fail to disclose that the elastomer is an elastomer that is capable of swelling when applied with fluid. Kramer teaches to have a seal that is formed from an elastomer that swells when applied with fluid. It would have been obvious to one having ordinary skill in the art at the time the invention was made to configure the elastomer of Evans and Blose to be a swellable elastomer as taught by Kramer to provide a sealing element that absorbs any fluid that leaks past a joint (column 4, lines 36-37 of Kramer).

#### ***Response to Arguments***

5. Applicant's arguments filed 5/20/05 have been fully considered but they are not persuasive.

Applicants' argument that Evans does not teach the thread portions define a thread cut in an opposite direction to an intended direction of rotation of a rotary expansion tool is not persuasive because as noted above that Evans teaches that an expansion tool can expand a joint from either direction (see column 10, lines 15-19).

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Applicants' argument about swelling elastomers is not persuasive because as evidence provided by Voitik (US. 3,945,650) that elastomers are known to swell when exposed to fluids (column 1, lines 25-35).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vishal Patel whose telephone number is 571-272-7060. The examiner can normally be reached on 6:30am to 8:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VP  
August 1, 2005

A handwritten signature in black ink, appearing to read 'Vishal Patel', is written over a horizontal line.

Vishal Patel  
Patent Examiner  
Tech. Center 3600